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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,739

03/18/2004

Bao Tran

AFL-016

8291

31688

7590

12/11/2009

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EXAMINER

SKINNER, SHEWANA D

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

12/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,739	Applicant(s) TRAN, BAO	
	Examiner SHEWANA SKINNER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/30/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant requested on 9/10/2009 to amend claims as noted, however applicant did not specify said claims, therefore Examiner is examining Applicant's claims filed on 6/18/2009.

Response to Arguments

2. Applicant's arguments on 6/18/2009 with respect to Claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant's arguments filed 6/18/2009 with respect to Claims 22-24 have been fully this considered but they are not persuasive. 'Applicant's invention cannot be distinguished from the prior art simply because of applicant's use of the word "automatically because it has been reasoned that "automatically" a process may be automatic even though a human initiates or may interrupt.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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1. **Claims 1-24** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant has several steps requiring a means for performing steps to create electronic documents and/or downloading documents i.e. “providing an electronic file wrapper”, “downloading file history information” however, applicant does not recite within the claims with what means, applicant is claiming in his invention, to perform said steps that would provide a person with notice of what applicant is claiming as his invention and therefore the claims are indefinite.

2. **Claim 19 and 20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “determining IPs required to provide freedom to operate” lacks a clear and precise definition within the specification. Applicant fails, within the specification and the claim to define what, per his invention, the “freedom to operate” is and how this step is performed. The language of the claim, considered as a whole in light of the specification and given its broadest reasonable interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation and is therefore indefinite.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 1-24** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim is statutory either by showing that his claim is tied to a particular machine, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. *In re Bilski*, slip opinion 2007-1130 (Fed. Cir. October 30, 2008).

Here, applicant's method steps fail the first prong of the new test because, although the phase "computer implemented" is recited within the preamble, there is no tie at all to a particular machine that is recited in the actual claims as a part of applicant's invention. In addition, dependent claims reference receiving information from the patent office computer however; first, said computer cannot be claimed as the particular machine comprised within applicant's invention and secondly, receiving information from said computer is an insignificant extra-solution activity that will not transform an unpatentable principle into a patentable process and third the word "automatic" does not inherently make it without human intervention therefore the two steps performed "automatically" do not inherently claim to a particular machine.

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Further, applicant's method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

The claims as recited are not tied to a particular machine and do not transform the numerical data inputted into a different state or thing. Therefore, the claims do not recite statutory subject matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-12 and 14-17** are rejected under 35 U.S.C. 102(b) as being anticipated by

Grainger (US 2002/0161733), hereinafter, “*Grainger I*”.

Grainger I discloses the following as claimed”

Claim 1 a computer-implemented method of facilitating the preparation of intellectual property documents [24] and [33] with an electronic workflow pipeline [26] and [30] where the user is authenticated with a patent office computer [1], [50] and [136], each file has an application identifier [57] tracking the status of pending patent applications [46], interfacing with the USPTO and downloading docket item(s) to the local database ([42] and [120] where examiner finds “new to be non-functional descriptive material to be not functionally involved in the steps

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recited. The step of downloading be performed the same regardless of how the type of item.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); and automatically adding a docket entry with a deadline for each new docket item [124].

Claim 2 (Original) The method of claim 1, wherein said document is a portable document format (PDF) document [64] and [117]

Claim 3 (Original) The method of claim 1, comprising generating a text-searchable PDF document containing all images for the entry. [47]

Claim 4 (Original) The method of claim 1, wherein the electronic file wrapper information includes a plurality of entries each having a mail-room date and a document description, comprising generating a single electronic document for each entry in the electronic file wrapper information.([57] and [58]where the file wrapper is the Case Data Unit and [59] where a single document is a Document Entity, [115] and [118])

Claim 5 (Currently Amended) The method of claim 1, comprising automatically determining a deadline from a mail-room date in the electronic file wrapper information [85].

Claim 6 (Currently Amended) The method of claim 1, comprising automatically docketing a deadline from a mail-room date in the electronic file wrapper information [84].

Claim 7 (Original) The method of claim 1, wherein the electronic file includes a folder containing at least one file for each entry, comprising periodically updating folder content

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with one or more new entries from the patent office electronic file wrapper information ([58] and [117], [120] upload document).

Claim 8 (Original) The method of claim 1, comprising generating a single electronic document for each new (non-functional descriptive material) entry in the electronic file wrapper information, the document having all images for the entry consolidated therein [59] and [115].

Claim 9(Original) The method of claim 1, wherein the electronic file wrapper information includes a plurality of entries each having a mail-room date and a document description, comprising providing docketing information based on the mail-room date([84], [85] and Fig 13 where examiner finds the mail-room date and a document description non-functional descriptive material.)

Claim 10 (Original) The method of claim 9, comprising generating a docket entry for one or more of the following: Information Disclosure Statement filing, foreign filing, Office Action response, response to missing part, notice of appeal, appeal brief, reply to response to appeal brief, notice of allowance, and annuity payment.([85] and [86] where a response to office action is docketed and [124] where a patent application with IDS is docketed)

Claim 11 (New) The method of claim 9, comprising generating an email reminder for the docket entry ([58] and [84] where the message is an email message).

Claim 12 (Original) The method of claim 9, comprising generating a docketing message to a recipient [84].

Claim 14 (Previously Presented) The method of claim 1, comprising filing one or more electronic documents with the patent office computer and automatically adding

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corresponding docket entries for the one or more electronic documents. ([6], [92], [75],[123] and [124])

Claim 15 (Previously Presented) The method of claim 14, wherein the electronic documents include one or more of the following: utility patent applications, Provisional applications, Biosequence listings, Pre-grant publication resubmissions~ bio-sequence submissions, assignments, Electronic Information Disclosure Statements (eIDS), Design applications, New plant applications, Corrected or revised patent application republications, Reissue applications, International Patent Cooperation Treaty (PCT) applications, and Reexamination requests ([92] IDS and Provisional) examiner notes non-functional the type of document to be nonfunctional descriptive material not functionally involved in the steps recited. The step of applying a rule would be performed the same regardless of the type of document. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).

Claims 16 and 17 (Original) The method of claim 1, comprising displaying the electronic document in a tri-fold format. [116] and [117]

7. **Claims 19-21** rejected under 35 U.S.C. 102 (b) as being unpatentable *Grainger et al* (US 2002/0059076) , hereinafter “*Grainger2*”

Claim 19. (Original) A method for providing an electronic file for intellectual property (IP)applications [7], comprising: searching one or more databases for one or more relevant IPs [60]; performing a network analysis (applicant fails to define within the claims therefore [194]

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an invention analysis and [196] testing data) on the relevant IPs; and determining IPs required to provide freedom to operate (applicant fails to define within the claims therefore [194] an invention analysis, [196] testing data and Fig 12) .

Claim 20. (Original) The method of claim 19, comprising acquiring the least number of IPs to provide freedom to operate (applicant fails to define within the claims therefore [194] an invention analysis, [196] testing data and Fig 12).

Claim 21. (Original) The method of claim 19, comprising: receiving electronic file wrapper information from a patent office computer ([2] and [74], receipt); and generating a single electronic document for an entry in the electronic file wrapper information, the document having all images for the entry consolidated therein ([99] and [105]).

8. **Claims 22-24** rejected under 35 U.S.C. 102 (b) as being unpatentable over *PAIR: Patent Application and Information Retrieval, Press Release (1999)*, hereinafter, "*PAIR*".

As per Claims 22-24, PAIR discloses receiving an assignee name in lieu of a patent number, published application number or application serial number (PAIR Press Release where applicant is assignee and assignee name 4 functions the same as customer number)," retrieving copies of all patents and published patent applications matching the assignee name (PAIR Press Release where assignee name functions that same as customer number); receiving an application serial number conforming to a format aa/bbbbbbb (PAIR, Use of System - Accessing Issued Patents); retrieving a published patent application matching the bbbbbbb (PAIR: Objectives); and generating a single electronic document having all pages of the patent application consolidated therein (Pair: Objectives) wherein the retrieving locates a plurality of matching patent

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applications, further comprising selecting the patent application whose Series Code matches aa (*Pair." Objectives*).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim13 rejected under 35 U.S.C. 103(a) as being unpatentable over *Grainger1* in view of *Simpson et al (US 6,549,894)* , hereinafter *Simpson*.

As per Claim 13 (Original) *Grainger1* discloses the method of claim 12, comprising coding the docketing message of the docketing message ([84] where the rules can include coding).

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However, it does not explicitly state the step of coding to indicate urgency.

Simpson discloses a computerized docketing system for intellectual property law with automatic due date alert where the actions a docketed in a color code that indicates the degree of urgency of the docket item (col 6 lines 2-17)

Therefore, from the teaching of *Grainger1*, it would have been obvious to one of ordinary skill in that art at the time the invention was made to include color coding in the docketing method as disclosed in *Simpson* in order to effectively alert a user of the system of matters requiring attention.

11. **Claim 18 is** rejected under 35 U.S.C. 103(a) as being unpatentable over *Grainger1* in view of *Grainger2*.

As per Claim 18, *Grainger1* discloses the method of claim 1, comprising searching one or more remote databases for one or more relevant intellectual properties (IPs) [96] and [97] where references are found relevant to the IDS).

However, it does not disclose performing a network analysis on the relevant IPs.

Grainger2 discloses at [194] an invention analysis and [196] testing data where an analysis is performed.

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Therefore, from the teaching of *Grainger1*, it would have been obvious to one of ordinary skill in that art at the time the invention was made to expand the IP search to an analysis as disclosed in *Grainger2* in order to provide an effective and complete method for securing intellectual property.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Lundberg* (US 7,142,713), *Grainger* (US 2002/0111824), *Grainger* (US 2002/0065677), *Shay et al* (US 2004/0158587), *Snyder* (US 2002/0111953).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWANA SKINNER whose telephone number is (571)270-7141. The examiner can normally be reached on Monday-Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mooneyham Janice can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHEWANA SKINNER/
Examiner, Art Unit 3689

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